

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	Tuschl et al.	Examiner:	Kimberly Chong
Serial No.:	10/589,449	Group Art Unit:	1635
Confirmation No:	5675	Docket:	1119-10 CON/PCT/US
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For:	ANTI-MICRORNA OLIGONUCLEOTIDE MOLECULES		

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**RESPONSE TO RESTRICTION REQUIREMENT
AND PRELIMINARY AMENDMENT**

Sir:

The following is in response to the Office Action mailed May 8, 2009. This response is being filed within the second month after the mailing date of the Office Action. Accordingly, a one-month extension of time is requested herein. Please amend the above-identified application as follows:

Response to Restriction Requirement begins on page 2 of this paper.

Amendments to the Claims begin on page 4 of this paper.

Remarks begin on page 11 of this paper.

Response to Restriction Requirement

In the Office Action mailed on May 8, 2009, the Examiner has imposed a Restriction Requirement to one of the following inventions under the provisions of 35 U.S.C. §121:

I. Claims 1-34 and 48, drawn to a single-stranded anti-microRNA molecule capable of inhibiting microRNP activity in a cell, classifiable in class 536, subclass 24.5.

II. Claims 35-40 and 49, drawn to a method of inhibiting microRNP activity in a cell by administering an anti-microRNA, classifiable in class 514, subclass 44.

III. Claims 41-47, drawn to a microRNA molecule, classifiable in class 536, subclass 24.5.

In response, Applicants elect the claims of Group III, i.e., Claims 41-47, without traverse.

In the Restriction Requirement, the examiner further indicates that the claims of Groups I or III are subject to a further restriction. More specifically, the examiner asserts that a search of more than one of the sequences claimed in Claims 1, 41, 45 and 48 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one of the claimed sequences. Accordingly, the examiner requests one sequence to be elected for examination.

On page 8 of this Response, Applicants have amended Claim 41 to delete the general list of microRNA molecules shown in Table 2. Instead, Claim 41 now identifies the microRNA molecule identified in SEQ ID NO. 139 or its corresponding anti-microRNA molecule identified in SEQ ID NO. 445.

Applicants traverse this portion of the Restriction Requirement only to the extent it is alleged by the examiner that it would be an undue burden to search not only the microRNA, but also its corresponding anti-microRNA sequence.

In addition, the examiner has required restriction between product and process claims. The examiner confirms that process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. The examiner further notes that, in the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. 1.104. The examiner advises Applicants that the process claims should be amended during prosecution either to maintain dependency on the product claims or otherwise include the limitations of the product claims, and that failure to do so may result in a loss of the right to rejoinder.

Accordingly, Applicants have amended independent Claim 35 relating to a method for inhibiting microRNP activity in a cell. More specifically, Claim 35 has been amended to include the anti-microRNA molecule identified in SEQ ID NO. 445, as set forth in Claim 41. Upon allowance of Claim 41, rejoinder of Claim 35 will be respectfully requested.